

REMARKS

Applicant has thoroughly considered the Advisory action and has amended the application to more clearly set forth the invention. The claims previously presented have been canceled and claims 22 - 39 have been added. Reconsideration of the application as amended and in view of the following remarks is respectfully requested.

Applicant respectfully disagrees with the Examiner's statement that "the concept of manufacturing is new to the specification and among other considerations, introduces the concept of large scale production."

First, in demonstrating that the concept of manufacturing is not new matter, Applicant, in Amendment B, pages 7 lines 15-25, explained that the original specification provides support for the concept of manufacturing by discussing the concept of making and producing. For example, in the first paragraph of the Summary of the Invention, the specification discloses "a knowledge base contains a plurality of parameters which relate to embroidery designs and the process of making an embroidered fabric from an embroidered design (p. 2, ll. 19-22)." Second, the specification describes the invention having "one purpose of the expert system and method of this invention is to allow operators who wish to produce an embroidered fabric from an embroidery design (p. 4, ll. 16-19)..." Hence, the concept of manufacturing is not new matter.

Second, the definition provided in Amendment B, page 7 lines 24-25 states that manufacturing means "to make or produce by hand or machinery, esp. in large scale". The abbreviation "esp." (i.e. especially) is to denote and exemplify "manufacturing" to incorporate the concept of large scale production which may be special to the concept of manufacturing.

Third, the original specification discloses the concept of making and producing, which may include large or small scale production. In other words, by disclosing the concept of making and producing in the original specification, the present invention is not limited to making or producing in large or small scale production. Therefore, the concept of large scale production is also not new matter.

While Applicant respectfully disagrees with the Examiner's interpretation on the issue of new matter, Applicant has amended the claims by canceling all claims and adding new claims 22 to 39 to more clearly set forth the invention and to remove the references to the concept of manufacturing. For example, claim 22 recites, in part:

A computer-implemented system for assisting an operator of an embroidery machine to make an embroidered fabric from an embroidery design using the embroidery machine, said computer-implemented system comprising:

a knowledge base of parameters for making the embroidered fabric from the embroidery design . . .;

selection software . . . for defining a parameter for making the embroidered fabric . . .;

analysis software . . . for generating one or more recommended parameters for making the embroidered fabric . . .;

display software for providing a display corresponding to the selected and defined parameters and corresponding to the one or more recommended parameters such that the one or more recommended parameters define parameters for making the embroidered fabric from the embroidery design using the embroidery machine.

The new claims 28 and 34 provide similar recitals.

Thus, the claims distinguish over the prior art which relates to embroidery designs. In contrast, the claims recite

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parameters for making the embroidered fabric from the embroidery designs of the prior art. Therefore, Applicant respectfully requests the removal of objection regarding the issue of new matter and reconsideration of the claims in light of the foregoing remarks.

CONCLUSION

It is felt a full and complete response has been made to the Advisory action and, as such, places the application in condition for allowance. Such allowance is respectfully requested. Applicants invite the Examiner to telephone the undersigned to schedule an interview at the Examiner's convenience to discuss Amendment C.

Applicants believe that no fees are due in connection with this Amendment C. However, if the Commissioner determines that fees are due, he is hereby authorized to charge said government fees during the entire pendency of the prosecution to Deposit Account No. 19-1345.

Respectfully submitted,



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